



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,552	02/16/2001	Shinji Okazaki	7217/63755	3126

7590 08/11/2004

COOPER & DUNHAM LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

FERGUSON, KEITH

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 08/11/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,552

Applicant(s)

OKAZAKI ET AL.

Examiner

Keith T. Ferguson

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 17-22 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2683

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1,2, and 4-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1,2,4-9,12-14 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boling et al. in view of Oyama and Tsukagoshi, newly recited reference.

Regarding claim 1, Boling et al. discloses a method of controlling a communication terminal (player/phone) that communicates with a base station (inherent, for a base station to be connected to a central paging service which is connected to a private emergency response service, as taught in col. 4 lines 20-47 and col. 5 lines 30-47) by radio waves (col. 4 lines 20-47 and

Art Unit: 2683

col. 5 lines 30-47), comprising the steps of: enabling said radio communication to be executed when a registration processing (i.e. the player/phone sends its identification and location information to the central paging service) (col. 4 lines 20-47 and col. 7 lines 25-40) concerning a predetermined communication (an emergency 911 call) is executed (col. 4 lines 20-47 and col. 7 lines 25-40); and limiting (i.e. by placing the player/phone in an audio mode which a switch inside the player/phone sends an audio signal to an earphone) (fig. 4 numbers 40 44 and 8, fig. 8 numbers 40, 44 and 8; col. 6 lines 40-52 and col. 9 lines 55-64) a processing for executing a predetermined function (audio mode) other than said radio communication when said registration processing is not executed (selected for emergency call processing) (fig. 4 numbers 40, 44 and 8, fig. 8 numbers 40, 44 and 8; col. 6 lines 40-52 and col. 9 lines 55-64). Boling et al. differs from claim 1 of the present invention in that it does not explicit disclose a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station. Oyama teaches a predetermined base station (col. 12 lines 1-41). Tsukagoshi teaches a registration process that comprises receiving and registering controlling data (i.e. a temporary id) transmitted by a base station (col. 4 lines 20-

Art Unit: 2683

42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boling et al. base station with a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station in order to speed up the player/phone registration process by registering with a specified base station when the player/phone identification matches the player/phone identification stored at the predetermined base station when seeking emergency assistant in the area where the emergency call is permitted, as taught by Oyama, and Tsukagoshi.

Regarding claim 2, Boling et al. discloses said registration processing is comprised of registering predetermined identification data within a terminal (col. 4 lines 20-47 and col. 7 lines 25-40).

Regarding claim 4, Boling et al. discloses said registration processing is comprised of receiving position registration permitting data sent from said predetermined base station after a position registration requesting signal has been transmitted to said predetermined base station when a power

Art Unit: 2683

switch of said communication terminal is turned on (inherent, since the player/phone receives incoming communication signals transmitted by the emergency response center, as taught in col. 5 lines 30-42 and col. 7 lines 14-40).

Regarding claim 5, the combination of Boling et al. and Oyama differs from claim 5 of the present invention in that they do not disclose said registration processing is comprised of receiving position registration permitting data sent from said predetermined base station after a position registration requesting signal has been transmitted to said predetermined base station when a position of said communication terminal is moved. Tsukagoshi teaches a registration processing comprise receiving position registration permitting data sent from said predetermined base station (carrier B) after a position registration requesting signal has been transmitted to said predetermined base station when a position of said communication terminal is moved (network of carrier B) (col. 4 line 50 through col. 5 line 28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Boling et al. and Oyama with said registration processing is comprised of receiving position registration permitting data sent from said predetermined base

Art Unit: 2683

station after a position registration requesting signal has been transmitted to said predetermined base station when a position of said communication terminal is moved in order to notify the player/phone that the area which it is located is eligible for wireless service, as taught by Tsukagoshi.

Regarding claim 6, Boling et al. discloses said processing for executing said predetermined function is limited when a period during which a communication with said predetermined base station is not normally transmitted (i.e. the player/phone in audio mode or am/fm mode, as taught in col. 6 lines 15-62 and col. 9 lines 55-64).

Regarding claim 7, Boling et al. discloses a communication terminal apparatus (fig.1) comprising: radio communication means for communicating with a base station (inherent, for a base station to be connected to a central paging service which is connected to a private emergency response service, as taught in col. 4 lines 20-47 and col. 5 lines 30-47) by radio waves (col. 4 lines 20-47 and col. 5 lines 30-47); first data processing means (fig. 8 numbers 50 and 36) for processing data transmitted by said radio communication means (fig. 8 number 5) and data

Art Unit: 2683

received by said radio communication means (col. 4 lines 20-44 and col. 5 lines 30-64); second data processing means for executing a predetermined function (audio mode or audio am/fm mode) that is not related to said data processing (col. 6 lines 15-62 and col. 9 lines 55-64); operation means (fig. 8 numbers 76 and 36) for executing operations to execute said predetermined function (col. 6 lines 15-62 and col. 9 lines 55-64) and control means (controller) (figure 5 number 36) for controlling said processing at said radio communication means (col. 4 lines 20-39, col. 5 lines 9-63 and col. 7 lines 14-40 and fig. 5 numbers 5, 52, 58 and 60) and said first data processing means (col. 4 lines 20-39, col. 5 lines 9-63 and col. 7 lines 14-40) and said second data processing means (col. 6 lines 16-63) and enabling said second data processing means to execute said processing only when it is determined that a setting concerning said communication satisfies a constant condition (i.e. a switch 40b, fig. 4, is set for audio mode) (col. 6 lines 40-53). Boling et al. differs from claim 7 of the present invention in that it does not explicit disclose a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station. Oyama teaches a predetermined base station (col. 12 lines 1-41). Tsukagoshi teaches a registration process that

Art Unit: 2683

comprises receiving and registering controlling data (i.e. a temporary id) transmitted by a base station (col. 4 lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boling et al. base station with a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station in order to speed up a registration process when seeking emergency assistant by registering with a base station identity located within its memory in the area where the emergency call is permitted as taught by Oyama, and Tsukagoshi.

Regarding claims 12 and 17, the combination of Boling et al., Oyama and Tsukagoshi differs from claims 12 and 17 of the present invention in that they do not explicit disclose said constant condition determined by said control means is that a period during which said radio communication means does not transmit or receive data normally falls within a predetermined period. However, Boling et al. discloses a switch (fig. 8 numbers 40 and 40b) when set to am/fm receiver mode (fig. 8 number 76) is selected and the radio communication means (i.e. the cellular receiver 60 is not selected (fig. 8 numbers 40 and 40a). Therefore, it would have been obvious to one of ordinary

Art Unit: 2683

skill in the art at the time the invention was made to provide the combination of Boling et al., Oyama and Tsukagoshi with said constant condition determined by said control means is that a period during which said radio communication means does not transmit or receive data normally falls within a predetermined period in order for the user of the player/phone to listen to music when riding on a bus.

Regarding claim 8, Boling et al. said terminal is registered (i.e. the player/phone receives two-way service) (col. 4 lines 20-47).

Regarding claim 9, Boling et al. discloses said constant condition determined by said control means is that said data received by said radio communication means is not stored (i.e. communication is establish and received through the earphone) (col. 4 lines 20-44).

Regarding claim 13, Boling et al. discloses a communication system (col. 4 lines 20-47) in which a base station (inherent, for a base station to be connected to a central paging service which is connected to a private emergency response

Art Unit: 2683

service, as taught in col. 4 lines 20-47 and col. 5 lines 30-47) and a communication terminal (player/phone) communicate with each other by a method utilizing radio waves (col. 4 lines 20-47 and col. 5 lines 30-47), said method comprising the steps of permitting said communication terminal to communicate when a predetermined registration process is executed (col. 4 lines 20-39 and col. 7 lines 13-40); and limiting (i.e. by placing the player/phone in an audio mode which a switch inside the player/phone sends an audio signal to an earphone) (fig. 4 numbers 40, 44, and 8, fig. 8 numbers 40, 44 and 8; col. 6 lines 40-52 and col. 9 lines 55-64) a processing for executing a predetermined function (audio mode) other than said radio communication when said registration processing is not executed (selected for emergency call processing) (fig. 4 numbers 40, 44 and 8, fig. 8 numbers 40, 44 and 8, col. 6 lines 40-52 and col. 9 lines 55-64). Boling et al. differs from claim 13 of the present invention in that it does not explicit disclose a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station. Oyama teaches a predetermined base station (col. 12 lines 1-41). Tsukagoshi teaches a registration process that comprises receiving and registering controlling data (i.e. a temporary id)

Art Unit: 2683

transmitted by a base station (col. 4 lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boling et al. base station with a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station in order for the communication system to speed up the player/phone registration process by registering with a base station identity located within its memory when seeking emergency assistant within the area where the emergency call is permitted, as taught by Oyama and Tsukagoshi.

Regarding claim 14, Boling et al. discloses a communication management center (central paging service) (col. 4 lines 20-29).

Regarding claims 18 and 19, Boling et al. discloses a communication terminal apparatus (fig.1) comprising: radio communication means for communicating with a base station (inherent, for a base station to be connected to a central paging service which is connected to a private emergency response service, as taught in col. 4 lines 20-47 and col. 5 lines 30-47) by radio waves (col. 4 lines 20-47 and col. 5 lines 30-47); first data processing means (fig. 8 numbers 50 and 36 and col. 4 lines

Art Unit: 2683

20-47 and col. 5 lines 30-47) for processing data transmitted by said radio communication means (fig. 8 number 5) and data received by said radio communication means (col. 4 lines 20-44 and col. 5 lines 30-64); second data processing means for executing a predetermined function (audio mode or audio am/fm mode) that is not related to said data processing (col. 6 lines 15-62 and col. 9 lines 55-64); operating means (i.e. the player/phone in placed in audio mode) for setting an operation mode (col. 6 lines 17-21); and control means (controller) (fig. 4 number 36) for stopping (i.e. a switch for switching a cellular telephone mode to an audio mode by moving the switch from position 40a to 40b, taught in fig. 4 number 40 and col. 6 lines 40-52) a transmission processing of said radio communication means and permitting said second data processing means to execute said predetermined function when said operation mode is set to a predetermined operation mode by said operating means (fig. 4 numbers 40a-40c and col. 6 lines 40-52). Boling et al. differs from claim 18 of the present invention in that it does not explicit disclose a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station. Oyama teaches a predetermined base station (col. 12 lines 1-41). Tsukagoshi teaches a registration process that

Art Unit: 2683

comprises receiving and registering controlling data (i.e. a temporary id) transmitted by a base station (col. 4 lines 20-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Boling et al. base station with a predetermined base station and said registration processing is comprised of receiving and registering controlling data transmitted from said predetermined base station in order to speed up the player/phone registration process by registering with a base station identity located within its memory when seeking emergency assistant within the area where the emergency call is permitted, as taught by Oyama and Tsukagoshi.

Regarding claim 20, Boling et al. discloses wherein said predetermined function executed by said second data processing means is a music function (fig. 8 numbers 40, 40b and 76 and col. 9 lines 55-64).

Regarding claim 21, Boling et al. discloses a control to stop said transmission processing performed by said control means stops a supply of power to a transmission processing circuit (col. 9 lines 17-25).

Art Unit: 2683

Regarding claim 22, Boling et al. discloses a circuit for said stopping of said supply of power is an amplifying circuit (cellular communication circuit) for amplifying a transmission signal (col. 9 lines 17-25).

4. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boling et al. in view of Oyama and Tsukagoshi as applied to claims 7 and 9 above and in further view of Rune.

Regarding claim 10, the combination of Boling et al., Oyama and Tsukagoshi differs from claim 10 of the present invention in that they do not disclose said data is data for rejecting a registration sent in response to a position registration requesting signal transmitted to said predetermined base station when a power switch of said terminal apparatus is turned on. Rune teaches data for rejecting a registration sent in response to a position registration requesting signal transmitted to a network when a power switch of said terminal apparatus is turned on (col. 4 lines 8-20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Boling et al., Oyama and Tsukagoshi with said data is data for

Art Unit: 2683

rejecting a registration sent in response to a position registration requesting signal transmitted to said predetermined base station when a power switch of said terminal apparatus is turned on in order to inform the player/phone that its wireless contract agreement is expired, or deny service to the player/phone when the identification data sent to the paging service is fraudulent, as taught by Rune.

Regarding claim 11, the combination of Boling et al., Oyama and Tsukagoshi differs from claim 11 of the present invention in that they do not disclose data for rejecting a registration sent in response to a position registration requesting signal transmitted to said predetermined base station when said position of a terminal apparatus is moved. Rune teaches data for rejecting a registration sent in response to a position registration requesting signal transmitted to a network when said position of a terminal apparatus is moved. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Boling et al., Oyama and Tsukagoshi with data for rejecting a registration sent in response to a position registration requesting signal transmitted to said predetermined base station when said position of a terminal apparatus is moved in order to

Art Unit: 2683

notify the player/phone that it can not receive wireless service where it is located, as taught by Rune.

Allowable Subject Matter

5. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 15, the prior art of record fails to teach or suggest, alone or in combination wherein data for limiting said predetermined function at said communication terminal is transmitted when identification data transmitted from said communication terminal is identification data that is not registered on said communication management center.

Regarding claim 16, the prior art of record fails to teach or suggest, alone or in combination said identifying data contained in a position registration request transmitted from said communication terminal is not registered on said communication Management center, said base station transmits data for rejecting a position registration of said communication

Art Unit: 2683

terminal to said communication terminal and said communication terminal limits said predetermined function when it receives said data for rejecting said position registration.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T.

Art Unit: 2683

Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith Ferguson
Art Unit 2683
July 28, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600